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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,407	05/18/1999	JACK RICHARDSON LORRAINE	99P7558US01	3861

7590 12/04/2002
MOGAN, LEWIS & BOCKIUS, LLP
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EXAMINER

MILLER, CARL STUART

ART UNIT	PAPER NUMBER
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3747

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/313,407

Applicant(s)

LORRAINE

Examiner

Miller

Group Art Unit

3247

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 8/22/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-18 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-18 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

The amendment filed October 19, 2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The relative lengths of the sides of the clip was never included in the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, while this paragraph covers situations in which the disclosure is inadequate, it is also used to describe new matter situations. Applicant's response addresses whether or not the amended disclosure is adequate to make or use the invention, but the central issue is whether or not this is possible under the original disclosure, absent the new matter now included. The examiner has examined the drawings and, in particular, Figure 3 and notes that the relative sizes of the sides are not clearly shown and, in fact, measuring the drawing sides perhaps results in the sizes being the opposite of those claimed. Applicant may wish to file a continuation-in-part in order to avoid this rejection in future actions.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.


Claims 1-10, and 12-18 (as understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Bassler in view of Taylor. Bassler and Taylor apply as per the last two office actions.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bassler and Taylor as applied to claim 10 above, and further in view of Harrell. ✓

Bassler, Taylor and Harrell apply as per the previous office actions.

Applicant's arguments filed August 22, 2002 have been fully considered but they are not persuasive. In particular, with regard to the rejection under 35U.S.C. 112 first paragraph, this action has been made non-final because it may have been somewhat unclear that the real problem with applicant's claims is a new matter problem. Therefore, the examiner has now identified this problem explicitly by including a new matter objection in the response.

Secondly, applicant's arguments with regard to the art applied really go to the new matter issue as well since the relative size of the clip sides is involved. Without the objectionable limitations, which the examiner believes should be removed, the arguments become moot.


Carl S. Miller
Primary Examiner